

## REMARKS

The office action mailed December 9, 2003 is acknowledged. Claims 1-22 are pending in the application and have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Beelitz in view of Ross and further in view of Soehnlen. In keeping with the foregoing amendments and the following arguments, reconsideration of the rejected claims is respectfully requested.

### **A. The Soehnlen reference is not analogous art**

At the outset, no rejection based even in part on the Soehnlen reference can stand, as the Soehnlen reference is plainly non-analogous art. "A reference is reasonably pertinent if, even though it may be in a different field from that of the inventor's endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor's attention in considering his problem." In re Clay, 966 F.2d 656, 659 (Fed. Cir. 1992).

Here, no reasonable inventor concerned with methods and apparatus for fulfilling electronic book orders on demand would ever have thought to look to an ice cream manufacturing and packaging process and a package for such a process. One simply would not look to ice cream manufacturing and its associated mix, tank, cooler, ingredients, fillers, cryogenic gas stations, hardeners, lidders, labelers, etc., all of which have nothing whatsoever to do with the claimed invention, to solve problems relating to fulfilling, printing and binding electronic book orders. It is well accepted law that non-analogous art can never establish obviousness, *prima facie* or otherwise. Accordingly, Soehnlen cannot be used to make an obviousness rejection. Any rejection based even in part on Soehnlen is overcome, and therefore claims 1-22 are in allowable form.

**B. The combination fails to teach/suggest claim limitations**

The cited combination cannot support a *prima facie* case of obviousness<sup>1</sup>. Claim 1 fulfills book orders and positively recites, in part, retrieving first book content, printing a first book, retrieving second book content, printing a second book, packaging the first and second books, and addressing separate mailers for the books.

By comparison, the Beelitz reference does not print a book and cannot possibly fulfill a book order. Instead, the invention of Beelitz, in an optional step, only prints out a data file when a person manually enters order data during the manufacturing process. Col. 5, lines 46-51. Further, a printed data file is not a book, and there would be no suggestion in the reference, nor has any suggestion been offered, to package a data file, or to address a data file.

Soehnlen adds nothing of relevance. Instead, Soehnlen merely applies what appear to be pre-printed labels to packages of ice cream. Further, applicant suggests that there would be no reason to package ice cream in a mailer, as the ice cream would surely melt during shipping. Accordingly, there cannot be a *prima facie* case of obviousness, and the rejection must be withdrawn. Claim 1 is in allowable form.

Claims 2-8 depend from claim 1, either directly or through intervening claims. Accordingly, claims 2-8 are also in allowable form.

---

<sup>1</sup> To establish a *prima facie* case of obviousness, three basic criteria must be met:

- (a) First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
- (b) Second, there must be a reasonable expectation of success.
- (c) Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

Claim 9 relates to fulfilling bulk orders and positively recites, in part, printing a first book identified light a book identifier in a printing press after receiving the book identifier a destination address and payment information. By comparison, Beelitz says nothing about a printing press. A printer for printing a data file as in the reference is not a printing press. Further, there would be no suggestion to use a printing press in order to print a simple data file, nor would there be any suggestion to address the data file for shipping. In fact, the reference specifically states that the data file is for use when performing one of the manufacturing process steps manually. Column 5, lines 46-51. Moreover, the Soehnlen reference again adds nothing of relevance, in that the Soehnlen reference simply applies pre-printed labels to ice cream packages. Therefore, the rejection is overcome and claim 9 is in allowable form.

Claims 10-13 depend from claim 9, either directly or through intervening claims. Accordingly, claims 10-13 are in allowable form.

Claim 14 relates to a printing facility and positively recites, in part, a plurality of printers, a database, a book order server operatively coupled to a network receiver, and 80 digital memory structured to cause a processor to:

- (i) receive and decode book order data via the network receiver, the book order data including a website identifier, a book identifier, and a destination address;
- (ii) retrieve book content from the database based on the book identifier;
- (iii) print a book using the book content on at least one of the plurality of printers;
- (iv) select logo data indicative of a website logo, the logo data being selected based on the website identifier;
- (v) print the website logo on at least one of an invoice, a mailing label, and a mailing package; and

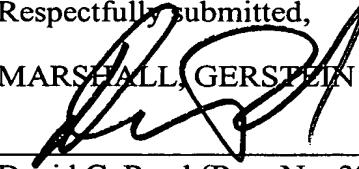
(vi) print the destination address on at least one of the invoice, the mailing label, and the mailing package.

By comparison, once again the Beelitz reference contains nothing of relevance relating to retrieving book content and printing a book using the book content on at least one of the plurality of printers. Soehlen merely applies pre-printed labels and does not print books at all. Therefore, there cannot be a *prima facie* case of obviousness, and claim 14 is in allowable form.

Claims 15-18 depend from claim 14. Therefore, claims 15-18 are also in allowable form.

Claim 18 recites, in part, a printer interface module structured to transmit book content to a printing press to print a book. By comparison, Beelitz does not print a book, and Soehnlen does not even print the pre-printed labels. Accordingly, claim 18, and the claims dependent thereon, are in allowable form.

In view of the foregoing, the above-identified application is in condition for allowance. In the event there is any remaining issue that the Examiner believes can be resolved by a telephone conference, the Examiner is respectfully invited to contact the undersigned attorney at (312) 474-6612.

Respectfully submitted,  
  
MARSHALL, GERSTEIN & BORUN LLP  
By \_\_\_\_\_  
David C. Read (Reg. No. 39,811)  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6402  
(312) 474-6300

May 10, 2004